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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/780,271  
Filing Date: February 17, 2004  
Appellant(s): HODGE ET AL.

\_\_\_\_\_  
George W. Moxon II  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/7/2011 appealing from the Office action mailed 6/7/2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

1, 3-16, 18-19, 22-30, 32-34, 36-41, 43-45 and 47-56.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

2003/0120729	KIM et al.	6-2003
6,820,094	FERGUSON et al.	11-2004
2004/0205448	GRFENSTETTE et al.	10-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the appellant regards as his invention.

**Claims 1, 3-16, 18-19, 22-30, 32-34, 36-41, 43-45 and 47-56 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. These claims are vague and ambiguous, and thus, their scope is indeterminable.

**Regarding independent claims 1, 27, 32-33, 40, 47 and 56:** Appellant argues on page 13 (in the 5<sup>th</sup> paragraph) of Appellant's Amendment filed 2/24/2010 that Appellants "preserve the link when the linked document is deleted from the system". Appellant further indicates that the claim language reflects that such link is "operable". It is unclear how such link can be considered "operable" as it "links" to a document that no longer exists.

It is also unclear what the claimed links are (especially in claim 27, 32-33, 40, 47 and 56), as Appellant discusses on page 14 (in the 1<sup>st</sup> full paragraph) of Appellant's Amendment filed 2/24/2010 that such links are "not limited to HTML" (a URL?), but can include C, Basic, etc. Appellant further argues on page 14 (in the 2<sup>nd</sup> full paragraph) of Appellant's Amendment filed 2/24/2010 that the claimed hyperlinks are not "general links", but it is unclear what a "C" language hyperlink is, for example.

**Claims 3-16, 18-19 and 22-26** depend upon claim 1, and therefore are likewise rejected.

**Claims 28-30** depend upon claim 27, and therefore are likewise rejected.

**Claims 34 and 36-39** depend upon claim 33, and therefore are likewise rejected.

**Claims 41 and 43-45** depend upon claim 40, and therefore are likewise rejected.

**Claims 48-55** depend upon claim 47, and therefore are likewise rejected.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-16, 18-19, 22-30, 32-34, 36-41, 43-45 and 47-56 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Kim et al. (US Patent Application Publication No. 2003/0120729, filed as a continuation of Application no. 08/908544, which was filed on Aug. 7, 1997 and published on Jan. 26, 2003, hereafter referred to as "Kim") in view of Ferguson et al. (US Patent No. 6,820,094, filed Oct. 8, 1997 and issued Nov. 16, 2004, hereafter referred to as "Ferguson") and Grefenstette et al. (US Patent Application Publication No. 2004/0205448, provisionally filed on Aug. 13, 2001 and published on Oct. 14, 2004, hereafter referred to as "Grefenstette").

**Regarding independent claim 1:** Kim discloses

***A digital computer system, including a terminal and a data-management system for generating a hyper link in real time between an electronic document opened in a computer application and a target document, said digital computer terminal comprising a computer readable memory and a data-capture device,*** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format) ***said data-management system comprising: data-capture logic for controlling capture of electronic data by said data-capture device;*** (See Figure 4 #4 in Kim, showing the use of a scanner.) ***target-document logic for generating said target document from said electronic data; and*** (See paragraph [0012] in Kim, discussing inputting a document to a scanner

or fax and creating a file.) ***link-generating logic for substantially simultaneously storing said target document in said computer readable memory and generating said hyper link to said target document in said electronic document in real time;*** (See paragraphs [0012] – [0014] in Kim, discussing automatic link generation and storage and noting that paragraph [0014] discusses retrieval of the created image file, which inherently required that the file be stored before being retrieved.) ***data-management logic for transmitting said electronic document and said target document to a data storage device*** (See paragraphs [0013] – [0014] in Kim, discussing the storage of documents.)

However, Kim does not explicitly teach the remaining limitations. Ferguson, though, teaches ***for opening, displaying, and editing said target document*** (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to “the modification of its corresponding document”. Additionally, it is noted that the same Ferguson passage discusses that a document may be modified. Such language is at least suggestive of opening/displaying/editing of a document. See also, col. 4 lines 43-56 discussing document editing and updating of the linkage mechanism.) ***wherein said data management logic and said link editing logic automatically updates the path of said hyper link to maintain functionality of said hyper link and to render said hyper link operable following said transmission*** Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data



storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to "the modification of its corresponding document".)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach ***and link-editing logic for updating a path of said hyper link***. (i.e., where the concept of a linkage mechanism is a hyperlink) Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links to content, and [0228] discussing that hyperlinks are examples of links to content.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

**Regarding claim 3:** Kim does not explicitly teach the use of top-level directories and subfolders. Ferguson, though, suggests this limitation. (See Figure 3 and column 4 lines 59-67 in Ferguson, illustrating the use of top-level folder and subdirectories. The specific data one arranged in a hierarchy was an obvious variant to one skilled in the art at the time of the invention.)

**Regarding claim 4:** Kim teaches the use of hard disk data storage. (See Figure 1 #3 in Kim, showing a file server computer, it having been well-known in the art that file server computers contain a hard drive.

**Regarding claim 5:** Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.)

**Regarding claims 6-12:** Kim does not explicitly teach the recited limitations. Ferguson, though, suggests these limitations. (See column 10 lines 9-11 in Ferguson, discussing the processing of multipage documents, and column 15 lines 34-40, discussing the linking of a plurality of documents to/from a compound document. Establishing links, whether in a 1:1, 1:MANY, MANY:1 or MANY:MANY fashion, was an obvious variant to one skilled in the art at the time of the invention.)

**Regarding claim 13:** Kim does not explicitly teach link removal. Ferguson, though, suggests this limitation. (See column 7 lines 53-57 in Ferguson, discussing the removal of only the link.)

**Regarding claims 14-16 and 18-19:** Kim does not explicitly teach the recited limitations. Ferguson, though, suggests the use of an add-in. (See Figure 12 in Ferguson, showing the display results for a browser application add-in.) Ferguson also suggests the use of a data management system for text documents. (See the Abstract of Ferguson, discussing a document management application program, it having been an obvious variant to one skilled in the art at the time of the invention as to number of software modules and the location of specific functionality in each module.) Ferguson also suggests link-editing/ updating. (See column 3 lines 59-65 in Ferguson, discussing the updating of an STG data storage file.) Ferguson teaches the use of icons. (See column 12 lines 41-52 in Ferguson, discussing the use of icons to represent hyperlinks.)

**Regarding claim 22:** Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.)

**Regarding claims 23-26:** Kim does not explicitly teach the recited limitations. Ferguson, though, suggests these limitations. (See column 10 lines 9-11, discussing the processing of multipage documents, and column 15 lines 34-40, discussing the linking of a plurality of documents to/from a compound document. Establishing links, whether in a 1:1, 1:MANY, MANY:1 or MANY:MANY fashion, was an obvious variant to one skilled in the art at the time of the invention.)

**Regarding independent claim 27:** Kim discloses

***A data-management system for generating a plurality of links to target documents in an electronic document,*** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format) ***said data-management system comprising: means for creating and editing an electronic document; means for generating a plurality of target documents from electronic data captured by a data-capture device;*** (See paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a file object.) ***means for storing said plurality of captured target documents in a computer readable memory; and means for generating a link at a plurality of user-selected locations in said electronic document to said plurality of captured target documents.*** (See paragraphs [0012] – [0014] in Kim, discussing automatic link generation and storage and noting that paragraph [0014] discusses

retrieval of the created image file, which inherently required that the file be stored before being retrieved. See also the passage at [0063] – [0064] discussing the inserting of links to scanned documents in the “appropriate place” [sic] in a pre-existing HTML document, for example.)

However, Kim does not explicitly teach editing, generation of a plurality of documents or use of sequential identifiers. Ferguson, though, suggests editing (e.g., ***for opening, displaying, and editing said target document***). (See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions. See also col. 3 lines 22-25 discussing the use of a general purpose computer. Additionally, it is noted that the Ferguson column 7 lines 47-57 discusses that a document may be modified. Such language is at least suggestive of opening/displaying/editing of a document.) Ferguson also suggests the generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped documents being formed from a plurality of documents such as images, Word documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound document from each component target document.) Ferguson further suggests the use of sequential identifiers for targets. (See column 5 lines 1-15 in Ferguson, discussing the sequential numbering of documents [e.g., D<sub>1</sub>, D<sub>2</sub>, etc.].) Ferguson also suggests ***and to render said hyper link operable following said transmission*** (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57,

discussing a scenario involving link generation due to "the modification of its corresponding document".).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach ***means for updating a path of said plurality of hyperlinks in a user selected range of said electronic document.*** (i.e., where the concept of a linkage mechanism is a hyperlink) Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links to content, and [0228] discussing that hyperlinks are examples of links to content.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

**Regarding claim 28:** Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.

**Regarding claim 29:** Kim teaches "transmitting" documents to storage. (See paragraphs [0013] – [0014] in Kim, discussing storage of documents.) However, Kim does not explicitly teach updating link paths. Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving updates requiring link elimination.)

**Claim 30** is substantially similar to claim 3, and therefore likewise rejected.

**Regarding independent claim 32:** Kim discloses

***A computer system for linking a target document to a portion of an electronic document in real time*** (See the Abstract of Kim, discussing automatic link generation to a scanned document file. See also, [0076] discussing the use of a link to a first page of an electronic document.), ***said computer system comprising: a computer for generating and editing an electronic document;*** (See the Abstract of

Kim, discussing the use of a scanner and generation of an electronic file.) ***link-generating logic operable with said computer application for generating a link to said target document, wherein said target document is an electronic reproduction of a hardcopy document and is to be generated by scanning said hardcopy document with an optical data-capture device, further wherein said link is to be generated at approximately the same time as said captured target document is to be saved, and further wherein said computer application is one of a group consisting of a spreadsheet, word processor, database, presentation application, and any combination thereof.*** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing a browser application and automatic link generation to an HTML page and storage, in context of [0005], discussing the conventional scanning of paper documents using an optical data-capture device such as a scanner. It is noted that paragraph [0014] discusses retrieval of the created image file, which requires that the file be stored. Also see [0076] discussing the use of a link to the first page [i.e., a “portion”) of a scanned document.)

However, Kim does not explicitly teach editing. Ferguson, though, suggests editing. (e.g., ***for opening, displaying, and editing said target document***). (See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions. See also col. 3 lines 22-25 discussing the use of a general purpose computer. Additionally, it is noted that the Ferguson column 7 lines 47-57 discusses that a document may be modified. Such language is at least suggestive of opening/displaying/editing of a



document.) Ferguson also suggests the generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped documents being formed from a plurality of documents such as images, Word documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound document from each component target document.) Ferguson further suggests the use of sequential identifiers for targets. (See column 5 lines 1-15 in Ferguson, discussing the sequential numbering of documents [e.g., D<sub>1</sub>, D<sub>2</sub>, etc.].) Ferguson also suggests ***and to render said hyper link operable following said transmission*** (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to “the modification of its corresponding document”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach ***and link-editing logic for updating a path of said link***; Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.) ***and the***

**link is automatically updated** Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

**Regarding independent claim 33:** Kim discloses:

***A data-management system for linking a portion of an electronic document to a target document,*** (See the Abstract of Kim, discussing linking an input image) ***said data-management system comprising: a data-capture device for capturing electronic data representing an information object;*** (See Figure 4 #4 in Kim, showing the use of a scanner.) ***means for generating said target document from said electronic data;*** (See paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a file.) ***a computer readable memory to store said target document;*** (See paragraph [0014] in Kim, which discusses the retrieval of the created image file, which required that the file be stored before being retrieved. It is

inherent that such data storage required a computer readable memory.) ***means for storing said target document in said computer readable memory and generating a link to said target document in said electronic document;*** (See paragraphs [0012] – [0014] in Kim, discussing automatic link generation and storage and noting that paragraph [0014] discusses retrieval of the created image file, which inherently required that the file be stored before being retrieved.) ***means for transmitting said electronic document and said target document to a data storage device;*** (See paragraphs [0013] – [0014] in Kim, discussing the storage of documents, it having been implied that if the document was stored that it had been “transmitted” to a storage device.)

However, Kim does not explicitly teach the remaining claim language. Ferguson, though, suggests editing (e.g., ***for opening, displaying, and editing said target document***). (See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions. See also col. 3 lines 22-25 discussing the use of a general purpose computer. Additionally, it is noted that the Ferguson column 7 lines 47-57 discusses that a document may be modified. Such language is at least suggestive of opening/displaying/editing of a document.) Ferguson also suggests the generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped documents being formed from a plurality of documents such as images, Word documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound document from each component target document.) Ferguson also suggests ***wherein said transmitting means automatically updates a path of said***

**link to render said link operable following transmission.** Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to “the modification of its corresponding document”.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach **and means for updating a path of said plurality of hyperlinks in a user-selected range of said electronic document;** (i.e., where the concept of a linkage mechanism is a hyperlink) Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links to content, and [0228] discussing that hyperlinks are examples of links to content.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the

Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

**Regarding claim 34:** Kim teaches the use of a scanner. (See paragraph [0012] of Kim.)

**Claims 36-37** are substantially similar to claims 3-4, respectively, and therefore likewise rejected. It is further noted that the exact “means” (e.g., hardware or software element) in which a particular functionality was implemented, was an obvious variant to one skilled in the art at the time of the invention.

**Regarding claims 38-39:** Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32, discussing a utility for viewing and printing documents.)

**Regarding independent claim 40:** Kim discloses:

***An electronic-document management method for creating and managing an electronic document having a link to a target document in a computer***

**application**, (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format) **said method comprising the steps of: generating a target document from electronic data representing an information object captured by a data-capture device; and** (See paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a file object.) **storing said target document in a computer readable memory and generating said link at said user-selected location in said electronic document** (See paragraphs [0012] – [0014] in Kim, discussing automatic link generation and storage and noting that paragraph [0014] discusses retrieval of the created image file, which inherently required that the file be stored before being retrieved.) **and transmitting said electronic document and said target document to a data storage device upon receiving a command from a user;** (See paragraphs [0013] – [0014] in Kim, discussing the storage of documents.)

However, Kim does not explicitly teach **and updating a path of said link to render said link operable after said transmission**. Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to “the modification of its corresponding document”.) Ferguson also suggests editing (e.g., **for opening, displaying, and editing said target document**). (See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions.

See also col. 3 lines 22-25 discussing the use of a general purpose computer. Additionally, it is noted that the Ferguson column 7 lines 47-57 discusses that a document may be modified. Such language is at least suggestive of opening/displaying/editing of a document.) Ferguson also suggests the generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped documents being formed from a plurality of documents such as images, Word documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound document from each component target document. It is further noted that the storage of such a document merely reflects an intended use of stored data/document.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach ***and updating the path of said link*** Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of

Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

**Regarding claim 41:** Kim does not explicitly teach document viewing.

Ferguson, though, suggests this limitation. (See Figure 1 element #169 and column 11 lines 28-32 in Ferguson, discussing document viewing.

**Claim 43** is substantially similar to claim 3, and therefore likewise rejected.

**Regarding claim 44:** Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.)

**Claim 45** is substantially similar to claim 18, and therefore likewise rejected.

**Regarding independent claim 47:** Kim discloses



***An electronic-document management method for creating and managing an electronic document having a plurality of links to target documents in a computer application,*** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format. It was an obvious variant to one skilled in the art at the time of the invention to include more than one link.) ***said method comprising the steps of: generating a plurality of target documents from electronic data representing one or more information objects captured by a data-capture device;*** (See paragraph [0012] in Kim, discussing inputting a document to a scanner or fax and creating a file object.) ***generating one or more links to the target documents in said electronic document.*** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format. It was an obvious variant to one skilled in the art at the time of the invention to include more than one link.)

However, Kim does not explicitly teach editing, generation of a plurality of documents or use of sequential identifiers. Ferguson, though, suggests editing (e.g., ***for opening, displaying, and editing said target document***). (See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions. See also col. 3 lines 22-25 discussing the use of a general purpose computer. Additionally, it is noted that the Ferguson column 7 lines 47-57 discusses that a document may be modified. Such

language is at least suggestive of opening/displaying/editing of a document.) Ferguson also suggests the generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped documents being formed from a plurality of documents such as images, Word documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound document from each component target document.) Ferguson further suggests the use of sequential identifiers for targets. (See column 5 lines 1-15 in Ferguson, discussing the sequential numbering of documents [e.g., D<sub>1</sub>, D<sub>2</sub>, etc.].) Ferguson also suggests **and render said hyper link operable following said transmission** (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to “the modification of its corresponding document”).).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach **and updating the path of said link**. Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

**Claims 48-49** are substantially similar to claim 42 and claim 3, respectively, and therefore likewise rejected.

**Regarding claim 50:** Kim does not explicitly teach printing. Ferguson, though, suggests this limitation. (See column 11 lines 29-32 in Ferguson, discussing a utility for viewing and printing documents.)

**Regarding claim 51:** Kim does not explicitly teach the use of icons. Ferguson teaches the use of icons. (See column 12 lines 41-52 in Ferguson, discussing the use of icons to represent links.)

**Regarding claim 52:** Kim does not explicitly teach updating link paths. Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson,

discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving updates requiring link elimination.)

**Regarding claim 53:** Kim does not explicitly teach user selected link locations, comparing the number of locations with the number of documents to be linked and generating a link for each document. Ferguson, though, suggests these limitations. (See column 9 lines 51-65 in Ferguson, discussing updating the importing documents, and column 9 lines 27-31, discussing the linking of multiple documents.)

**Claims 54-55** are substantially similar to claims 24-25, respectively, and therefore likewise rejected.

**Regarding independent claim 56:** Kim discloses:

***A data-management system for generating a hyperlink in real time between a portion of an electronic document opened in a computer application and a target document,*** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format. It was an obvious variant to one skilled in the art at the time of the invention to include more than one link.) ***said system comprising: a digital computer terminal comprising a computer readable memory and a data-capture device;*** (See Figure 2 #88 and #82 of Kim) ***data-capture logic in communication with said digital computer terminal***

**for controlling capture of electronic data by said data-capture device;** (See the Kim Figure 2 #80, 81 and 82, in context of paragraph [0012] discussing the use of a scanner.) **target-document logic in communication with said digital computer terminal for generating said target document from said electronic data;** (See the Abstract of Kim, discussing generation of a target document via a scanning process for display in a browser.) **link-generating logic in communication with said digital computer terminal for storing said target document in said computer readable memory and generating said link to said target document in said electronic document in real time;** (See the Abstract and paragraphs [0012] – [0014] in Kim, discussing automatic link generation between a target and an HTML document opened in a browser application upon scanning a document into a target file digital format. It was an obvious variant to one skilled in the art at the time of the invention to include more than one link.) **data-management logic for transmitting said electronic document and said target document to a data storage device;** (See paragraphs [0013] – [0014] in Kim, discussing the storage of documents.)

However, Kim does not explicitly teach **wherein said data-management logic automatically updates a path of said link to maintain functionality of said link following said transmission.** Ferguson, though, suggests this limitation. (See column 3 lines 59-65 in Ferguson, discussing updating the STG data storage file, in the context of column 7 lines 47-57, discussing a scenario involving link generation due to “the modification of its corresponding document”). Additionally, Kim does not explicitly teach

editing. Ferguson, though, suggests editing (e.g., **for opening, displaying, and editing said target document**). (See column 12 lines 8-15 in Ferguson, discussing an edit menu and editing functions. See also col. 3 lines 22-25 discussing the use of a general purpose computer. Additionally, it is noted that the Ferguson column 7 lines 47-57 discusses that a document may be modified. Such language is at least suggestive of opening/displaying/editing of a document.) Ferguson also suggests the generation of a plurality of target documents. (See column 15 lines 30-39 in Ferguson, discussing clipped documents being formed from a plurality of documents such as images, Word documents and HTML files, and column 15 line 63 – column 16 line 6, discussing links to a compound document from each component target document.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ferguson for the benefit of Kim, because to do so provided a user with an efficient way to automatically import, index, categorize, store, search, retrieve, manipulate and archive electronic documents, as taught by Ferguson in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

Additionally, Kim in view of Ferguson does not explicitly teach **link-editing logic for updating a path of said link**; Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.) **and said link updating logic for updating a path of said link automatically updates a path of said link to maintain functionality of said link following said transmission.**

Grefenstette, though, suggests this limitation. (See Grefenstette paragraph [0295] discussing the dynamic updating of links.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Grefenstette for the benefit of Kim in view of Ferguson, because to do so provided a user with a system for enriching or supplementing the document that the user is accessing, as taught by Grefenstette in the Abstract. These references were all applicable to the same field of endeavor, i.e., the management of electronic documents.

#### **(10) Response to Argument**

Appellant argues on pages 15-16 that the previous rejection of the claims under 35 USC 112, 2<sup>nd</sup> paragraph was incorrect because: 1) the specification describes several acts of selecting a document for deleting, removing "it from the target document to be linked", and updating the link "to the existing image"; and 2) because "the claim language alone, as a whole, is reasonably definite".

The Office respectfully disagrees with Appellant's remarks concerning the previous rejections of the claims under 35 USC 112-2nd paragraph: Appellant's **first** argument is unclear, and therefore appears to amplify the Office's concerns regarding

35 USC 112, second paragraph. Appellant has previously asserted that the claims encompass “preserv[ing] the link when the linked document is deleted from the system”. See the Remarks section on page 13 (in the 5<sup>th</sup> paragraph) of Appellant’s Amendment filed 2/24/2010. However, the issue here is that this “preserved link” is now referencing a document that no longer exists (i.e., was deleted). Therefore, it is unclear how a link to a non-existent document can possibly be “updated” to “maintain [the] functionality” of the link (as one end of that updated link points to a document that no longer exists). And thus the link would no longer be “operable”, as required by the claim language.

Additionally, Appellant’s second argument appears to be merely stating Appellant’s position (the claim language is “reasonably definite” because one skilled in the art would understand that links could be updated to maintain functionality). The Office maintains that the claim language is not definite, for at least the reasons presented above. Therefore, the claims have been properly rejected under 35 USC 112-2<sup>nd</sup> paragraph.

Appellant further argues at the bottom of page 16 that the previous rejection of the claims under 35 USC 112, 2<sup>nd</sup> paragraph was incorrect because the specification provides a clear definition for the claimed links.

The Office respectfully disagrees. For instance, Appellant previously argued that the claimed hyperlinks are not limited to HTML, and can include C, Basic, etc. See the Remarks section on page 14 (in the 1<sup>st</sup> full paragraph) of Appellant’s Amendment filed 2/24/2010. It was unclear as to what these claimed hyperlinks / links were (E.g., it is



unclear what a "C" language hyperlink is). Therefore, the claims have been properly rejected under 35 USC 112-2<sup>nd</sup> paragraph.

Appellant states on pages 17-18 that the previous rejection of the claims under 35 USC 103(a) was incorrect because the references do not teach several claimed concepts. Arguments are presented later in the Appeal Brief (hereafter "Brief").

The Office respectfully disagrees, noting that the references as a whole teach the claimed subject matter. Counter-arguments are presented later in the Examiner's Answer (Answer).

Regarding the previous rejection of claim 1 under 35 USC 103(a), Appellant argues on page 21 that Ferguson does not teach the claim language directed to opening, displaying, and editing a target document, and updating a path of the hyperlink.

The Office respectfully disagrees, noting that the references as a whole teach the recited claim language. It is noted that the Ferguson reference discusses the modification (i.e., editing) of a document. It is at least implied that one must "open" a document in order to modify it, and that one displays a document (at some point) to ensure that such modifications took effect. Ferguson discusses adjusting a document

linkage mechanism in col. 3 lines 62-65 in the context of col. 4 lines 43-56 and col. 7 line 47-57. In particular, Ferguson col. 4 lines 43-56 discusses that, in an exemplary embodiment, this linkage mechanism links a document and component documents, and that any document updates may be reflected. It is further noted that the Grefenstette reference has been cited for teaching that it was well known to one skilled in the art at the time of Appellant's subject matter that hyperlinks were also a mechanism for linking documents.

Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, *KSR International Co. v. Teleflex, Inc.*, 550 US 398, 82 USPQ2d 1385, 1397 indicates that:

A person of ordinary skill is also a person of ordinary creativity, not an automaton.

Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.

It was at least a matter of common sense that a variety of design options were within the knowledge, skills and abilities of those skilled in the art at the time of Appellant's subject matter, as evidenced by the cited art.

Therefore, the references have been reasonably interpreted as teaching the recited claim language.

Regarding the previous rejection of claim 1 under 35 USC 103(a), Appellant argues on pages 21-22 that Ferguson does not suggest automatically updating the path of a hyper link to maintain the functionality of the hyper link.

The Office respectfully disagrees, noting that the references as a whole teach the recited claim language. As previously noted, the Ferguson reference was cited for its teachings related to the updating of a linkage mechanism to maintain functionality with respect to referenced document components. See, for example, col. 3 lines 62-65 in the context of col. 4 lines 43-56 and col. 7 line 47-57 of Ferguson, teaching, *inter alia*, adjusting a linkage mechanism that links a document and component documents. Additionally, it is further noted that the Grefenstette reference, as discussed above, has been cited for teaching that it was well known to one skilled in the art at the time of Appellant's subject matter that hyperlinks were also a mechanism for linking documents.

Therefore, the references have been reasonably interpreted as teaching the recited claim language.

Regarding the previous rejection of claim 1 under 35 USC 103(a), Appellant argues on pages 22-23 that Grefenstette does not suggest logic for updating a path of a hyper link.

The Office respectfully disagrees, noting that the references as a whole teach the recited claim language. It is noted that Ferguson has been relied on for its teachings related to editing and updating a linkage mechanism. The Grefenstette reference was relied on for its teachings that hyperlinks were well known in the art as linkage mechanisms.

Therefore, the references have been reasonably interpreted as teaching the recited claim language.

Regarding the previous rejection of claim 1 under 35 USC 103(a), Appellant appears to argue on page 23 that motivation was improper because the references are from different fields of endeavor: namely, image file servers, a computer document system for organizing documents into a hierarchy, and systems for enriching meta-data documents.

The Office respectfully disagrees, and asserts that the references did, in fact, operate within the same field of endeavor - namely the management of electronic documents.

The Office further asserts *KSR International Co. v. Teleflex, Inc.*, 550 US 398, 82 USPQ2d 1385, 1397, which states:

The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [i.e., prior art reference] can provide a reason for combining the elements in the manner claimed.

Also, it is noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Therefore, motivation was properly established.

Appellant further argues on page 23 that dependent claims 3-16, 18-19 and 22-26 are allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claim 1.

Appellant further argues on pages 23-24 that independent claim 27 recites substantially similar limitations to claim 1, and therefore is allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claim 1.

Regarding the previous rejection of claim 27 under 35 USC 103(a), Appellant argues on page 24 that the references do not teach the claim language directed to generating a link at a plurality of user-selected locations in said electronic document to said plurality of captured target documents.

The Office respectfully disagrees, noting that the references as a whole teach the recited claim language. For example, paragraphs [0063] – [0064] of Kim discusses the inserting of links to scanned documents in the “appropriate place” [sic] in a pre-existing HTML page. Such discussions are reasonably suggestive of the recited claim

language, and indicate that one skilled in the art at the time of Appellant's subject matter was aware that more than one link may be inserted into a document.

However, regardless of one's interpretation of the Kim reference, it has been noted that the references as a whole teach the recited claim language. For instance, Ferguson discusses that it was conventionally known that one document can be linked to multiple documents in col. 4 lines 44-46.

Therefore, the references have been reasonably interpreted as teaching the recited claim language.

Appellant further argues on page 24 that dependent claims 28-30 are allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claim 27.

Appellant further argues on page 25 that claim 32 recites substantially similar limitations to claim 1, and therefore is allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claim 1.

Regarding the previous rejection of claim 32 under 35 USC 103(a), Appellant argues on page 25 that the references do not teach linking a target document to a portion of an electronic document.

The Office respectfully disagrees, noting that the references as a whole teach the recited claim language. First, it is noted that the Kim reference, at [0076] for example, discusses linking to the first page (i.e., a portion) of a scanned document. Such language is reasonably suggestive of the recited claim language.

However, regardless of one's interpretation of the Kim reference, it has been noted that the references as a whole teach the recited claim language. For instance, Ferguson discusses that it was conventionally known to include "text positioning information" in a linkage mechanism in col. 4 lines 24-28.

Therefore, the references have been reasonably interpreted as teaching the recited claim language.

Regarding the previous rejection of claim 32 under 35 USC 103(a), Appellant appears to argue on pages 25-26 that the references do not teach "said computer application is one of a group consisting of a spreadsheet, word processor, database,



presentation application, and any combination thereof and where the link-generating operable [sic] with said computer application”.

The Office respectfully disagrees, noting that the references as a whole teach the recited claim language. At least the Kim reference teaches generating a link that can be displayed in a browser (i.e., a “presentation application”, as recited in the last line of the claim). Mere creation of a link that is operable with a presentation application (recited but not listed in the arguments), for example, is all that is required by the claim language. It is also noted that Appellant also argues for a “flow chart” application. However, no such application was recited in the claim language.

Therefore, the references have been reasonably interpreted as teaching the recited claim language.

Appellant further argues on page 26 that independent claim 33 and dependent claims 34 and 36-39 recite substantially similar limitations to claims 1 and 32, and therefore is allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claims 1 and 32.

Appellant further argues on pages 26-27 that independent claim 40 and dependent claims 41 and 43-45 recite substantially similar limitations to claims 1, and therefore is allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claims 1.

Appellant further argues on page 27 that independent claim 47 and dependent claims 48-55 recite substantially similar limitations to claims 1, and therefore is allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claims 1.

Appellant appears to intend to argue under the heading "Claim 56" at the bottom of page 27 that independent claim 56 (not claim 33) recites substantially similar limitations to claims 1 and 32, and therefore is allowable for the reasons argued above.

The Office respectfully disagrees, and counter-asserts the rationale set forth above concerning claims 1 and 32.

It is further noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

The Office also notes MPEP § 2144.01, that quotes In re Preda, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968) as stating "in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." Further MPEP 2123, states that "a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

For at least these reasons, the Office maintains the previous rejections of the claims as set forth above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert Stevens/

Primary Examiner, Art Unit 2162

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/John E Breene/

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